

### **REMARKS**

This is a response to the Office Action of January 4, 2008. Applicant has carefully considered the rejections of the Examiner in the present application. In light of this consideration, Applicant believes that the claims remain allowable. Applicant respectfully requests reconsideration of the rejection of the claims now pending in the application.

The Applicant's wish to express appreciation for the Examiner's withdrawal of the Requirement for Restriction/ Election filed 7/13/2007.

In this the first "on the merits" Office Action of January 4, 2008, Claim 8 is rejected under first and second paragraphs of 35 USC §112. Claims 1-4, 7, 9-13 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,532,351 to Richards et al. (hereinafter Richards) in view of U.S. Application 2004/0080775 to Owen et al. (hereinafter Owen) in further view of U.S. Patent 5,930,553 to Hirst et al. (hereinafter Hirst). Claims 5-6, 8, and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Hirst and in further view of well known art. Claims 16-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of U.S. Patent 7,262,873 to Rasche et al. (hereinafter Rasche), in further view of U.S. Application 2003/0063305 to McIntyre (hereinafter McIntyre), in further view of Hirst. Claims 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Rasche, in further view of McIntyre, in further view of Hirst, and in further view of well known art.

Claim 8 is rejected under first and second paragraphs of 35 USC §112. The specification has been amended and it is believed that this amendment overcomes this rejection. Reconsideration of Claim 8 is respectfully requested.

Claims 1-4, 7, 9-13 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Hirst. Richards teaches how in a printer or copier, a removable module, such as a marking material supply module or a marking device module, is provided with a non-volatile memory chip which retains information about the cumulative use of the module and other performance-related data. The non-volatile memory is accessed through a wireless interface, such as an RF loop or IR detector, which is also associated with the module. The memory can be accessed, through wireless means, either by the printer or copier itself or by an external device, and also while the memory is not installed in a printer or copier.

The office action acknowledges that Richards fails to provide “a replaceable module comprising: ....a microprocessor connected to the internal memory, the peripheral memory and the communications device, the microprocessor performing the stored instructions to install the software upgrade into the printing apparatus via the communications interface”. For that the office action turns to Owen. However Owen fails to provide such teaching.

What Owen does provide is how a replaceable component is installable in and removable from a printing device and contains one or more supplies used in printing by the printing device. A memory and a port are in the replaceable component. Data that characterizes usage of the one or more supplies in printing by the printing device is stored in the memory. The data can be transferred through a cable from the port to a host computer using a data transfer protocol of the port.

So Owen teaches a replaceable component comprising a port. Owen **does not teach** a replaceable component comprising a microprocessor as the Applicants claim. What Owen does teach is to hook up a host computer *external* to the replaceable component via the port after removing the replaceable component from the printing device. Thus Owen actually teaches away from the Applicant's claimed invention by making the microprocessor external to the

replaceable component and connected to the replaceable component only when it is removed from the printing apparatus. This is in contradiction to the Applicants claims and thus a prima facie case of obviousness has not been made out.

The office action also relies upon Hirst. Hirst provides a consumable having a memory device for storing information such as usage information to be used by the original manufacturer or re-manufacturer. The memory device can also be used to provided software updates or patches for the microcomputers within an image forming or other office automation device. Thus Hirst also fails to provide for what Owen lacks. Reconsideration and allowance of claims 1-4, 7, 9-13 and 15 is respectfully requested.

Claims 16-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Rasche, in further view of McIntyre, in further view of Hirst. The failure of Richards in view of Owen to support a prima facie case of obviousness has been discussed above and holds true here as well. Owen fails to provide "a method of operating a replaceable module having a processor element *on board* the replaceable module" as the Applicants claim. Owen only teaches a host computer *external* to the replaceable component and hooked up via a port after removing the replaceable component from the printing device. This actually teaches away from the Applicants claimed invention.

The office action also relies upon Rasche in combination with Richards and Owen. Rasche teaches how a photoprinter may accesses remote digital photographs and files. A computer readable medium has one or more files, such as digital photographs. A computer has access to the files on the computer readable medium. A communication link connects the computer to a photoprinter. The photoprinter has a selection mechanism and access to the computer readable medium over the communication link in response to a user's input to the selection mechanism. Thus Rasche also fails to

provide for what Owen lacks. Reconsideration and allowance of claims 16-22 is respectfully requested.

Claims 5-6, 8, and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Hirst and in further view of well known art. Claims 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Owen, in further view of Rasche, in further view of McIntyre, in further view of Hirst, and in further view of well known art. However as these claims depend from claims deemed allowable they should be allowable as well. Reconsideration and allowance of claims 5-6, 8, 14, and 23-25 is respectfully requested.

The undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,

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